

2 and 3. Applicants hereby elect species 1 with traverse. Claims 1-11 are readable on the elected species.

Applicants respectfully submit that the restriction requirements are improper because a restriction is proper only when the examination of all of the claims would present a serious burden on the Examiner. See MPEP 803. All of the present claims are claims relating to modified phenolic resins. Applicants do not believe that examination of all of the claims would present a serious burden on the Examiner.

Furthermore, a process of making and a product made by the process can be shown to be distinct inventions only if (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; and/or (B) that the product as claimed can be made by another and materially different process. See MPEP § 806.05(f). Group I relates to a process of making a modified novolak and Group II relates to a product made by the process of Group I. The process as claimed in Group I is an obvious process of making the product of Group II because the claims in Group II depend, directly or indirectly, on claim 1 of Group I. Furthermore, the product as claimed in group II cannot be by another and materially different process because the product from the process of Group I is a polymeric mixture, the exact composition of which is difficult to be reproduced by another and materially different process. Therefore, Group I and Group II are not patentably distinct.

Similarly, Group I and Group III are not patentably distinct because Group I relates to a process of making a modified novolak and Group III relates to a modified novolak made by the process of Group I. The process of making a modified novolak as claimed in Group I is an obvious process of making the modified novolak of Group III because both are relates to modified novolak. Furthermore, the product as claimed in group III cannot be made by another and materially different process because the product from the process of Group I comprises at least one of Structures 1-9 which are difficult to be reproduced by another and materially different process. See specification at pages 17-25. Therefore, Group I and Group III are not patentably distinct.

In view of the above comments, Applicants respectfully request withdrawal of the restriction requirement asserting that there were three distinct inventions.

Furthermore, the restriction requirement asserting that there were four patentably distinct species is improper because the four species are not patentably distinct in

phenolic resin chemistry. When an aldehyde is in equilibrium with water, the aldehyde forms the corresponding dihydroxy compound. See attached article by John McMurry, *Organic Chemistry*, Brooks/Cole Publishing Company, p. 695 (1984). Similarly, the unsaturated aliphatic aldehyde compound and the corresponding unsaturated dihydroxy compound can derive from each other when they are in equilibrium with water. Therefore, the unsaturated aliphatic aldehyde compound and unsaturated dihydroxy compound are not patentably distinct because they can derive from each other.

The unsaturated aliphatic aldehyde compound has a C=C bond and a C=O bond whereas the aliphatic dialdehyde compound has two C=O bonds. The unsaturated aliphatic aldehyde compound and the aliphatic dialdehyde compound are not patentably distinct because the C=O bond is similar in many aspects to the C=C bond. See attached article by John McMurry, *Organic Chemistry*, Brooks/Cole Publishing Company, p. 672-673 (1984). It is particularly true in phenolic resin chemistry where nucleophilic addition to the C=O and C=C bonds may occur.

As a result of their similarities, the unsaturated dihydroxy compound, the unsaturated aliphatic aldehyde compound and the aliphatic dialdehyde compound all react with phenolic compounds to form modified phenolic resins. Therefore, species 1, 2 and 3 are not patentably distinct, particularly in phenolic resin chemistry. Because species 1, 2 and 3 are not patentably distinct from each other, a mixture of 1, 2, and 3, *i.e.*, species 4, is also not patentably distinct from them. Because the four species are not patentably distinct, particularly in phenolic resin chemistry, Applicants respectfully request withdrawal of the restriction requirement asserting that there were four patentably distinct species.


Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

No fee is believed to be due in connection with this Response. However, in the event that any fee is due, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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